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| 10/563,539 | 12/20/2005 | Alois Maier | HUBR-1288 | 8668 |
| 24972 | 7590 | 05/07/2009 | | |
| FULBRIGHT & JAWORSKI, LLP | | | EXAMINER | |
| 666 FIFTH AVE | | | LEONARD, MICHAEL L | |
| NEW YORK, NY 10103-3198 | | | ART UNIT | PAPER NUMBER |
| | | | 1796 | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/563,539

Applicant(s)

MAIER ET AL.

Examiner

MICHAEL LEONARD

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 30-70 is/are pending in the application.
- 4a) Of the above claim(s) 30-59 and 70 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 60-69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Election/Restrictions

Applicant's election with traverse of Group III, concerning claims 60-69 in the reply filed on 2/13/2009 is acknowledged. The traversal is on the ground(s) that U.S. Patent No. 5,189,135 does not anticipate the common inventive feature of the inventions of Groups I to III, which is seen in the provision of a fluorine modified polyurethane resin having a polymer bonded fluorine content of 1 to 4 wt.-% in the system as a whole. The initial argument that the U.S. document does not anticipate the common inventive feature of the claims is acknowledged. However, upon further search U.S. Patent Pub. No. 2004/0192835 to Steidl does meet the claimed language. Steidl discloses a one or two component polyurethane system having fluorinated side chains. The system comprises a binder component based on an aqueous solution of low molecular mass, hydroxyl and/or amino functional polyurethanes and an optional crosslinker component wherein said crosslinker component comprises polyisocyanates (0019-0028). Steidl further discloses that the fluorine content of the binder component is from 0.5 to 5% by weight and preferably from 0.5 to 2.0% by weight based on the resin solids, which anticipates the claim language of fluorine content between 1 to 4% by weight of the system (0029).

The requirement is still deemed proper and is therefore maintained..

Claims 30-59 and 70 are withdrawn from further consideration.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 60-69 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. Patent Pub. No. 2004/0192835 to Steidl et al.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

As to the claims, Steidl discloses an aqueous anti-graffiti and anti-soiling polyurethane coating systems useful at dirt-repellent anti-graffiti coatings on plastic, wood, or metal, for wind power plants and also for floor coverings and exterior ground coverings (Abstract). Steidl further discloses that polyurethanes containing

perfluoroalkyl groups are useful for oleophobic and hydrophobic treatment of textiles (0012).

Steidl discloses a one- or two component polyurethane system having fluorinated groups. The system comprises a binder component and optionally a crosslinker component. The binder component is based on fluoro-modified polyol component having reactive isocyanate functional groups and having a molecular mass of from 500 to 2000 Daltons, a high molecular mass polyol (500 to 6000 Daltons) and a low molecular mass polyol (50 to 499 Daltons) and a further polyisocyanate component composed of aliphatic or aromatic isocyanate groups (0020-21). Steidl further discloses the presence of a catalyst and solvent (0022-0023) and further discloses an optional polyisocyanate crosslinking agent (0028). The fluorine content of the polyurethane polymer falls within the range of 0.5 to 5% by weight of the polymer composition (0029).

Steidl discloses anti-graffiti coatings and mentions the use of perfluoroalkyl containing polyurethanes for oleophobic and hydrophobic coatings. As a result, it would have been obvious to a person of ordinary skill in the art to use the polymers disclosed by Steidl for providing oil- and water-repellent surfaces to certain substrates. Steidl discloses mineral and nonmineral surfaces such as concrete, plaster, ceramic, clay, and cement as well as wood, wood-based materials, plastic, metal, paper, composites and/or leather (0088) that the coating can be applied on, which are the same surfaces as the instant claims. The selection of a known material (perfluorinated polyurethanes) based on its suitability for its intended use (oil- and water-repellency) supports a prima

facie case of obviousness (See MPEP 2144.07). See WO97/36951 or US-5703194 or US-2003/0026997.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL LEONARD whose telephone number is (571)270-7450. The examiner can normally be reached on Mon-Fri 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MICHAEL LEONARD/
Examiner, Art Unit 1796

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/Randy Gulakowski/

Supervisory Patent Examiner, Art Unit 1796